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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,875	12/01/2006	Kristen Briggs	P0850.70005US01	6405
23628 7590 01/22/2009 WOLF GREENFIELD & SACKS, P.C. 600 ATLANTIC AVENUE BOSTON, MA 02210-2206				
EXAMINER				
WORLEY, CATHY KINGDON				
ART UNIT		PAPER NUMBER		
1638				
MAIL DATE		DELIVERY MODE		
01/22/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/536,875

Applicant(s)

BRIGGS ET AL.

Examiner

CATHY K. WORLEY

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64, 66-69, 75 and 76 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-64, 66-69, 75, and 76 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

1. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-31, 38-53, 75, and 76, drawn to a plant-produced immunoglobulin, wherein the immunoglobulin has a glycopeptides profile comprising at least one glycopeptides which lacks fucose.

Group II, claim(s) 32-37, drawn to a plant cell, plant tissue, plant callus, plantlet, whole plant or seed comprising an immunoglobulin, wherein the immunoglobulin has a glycopeptides profile comprising at least one glycopeptides which lacks fucose.

Groups III-VII, claim(s) 64 (in part), drawn to a method that utilizes a specific vector; wherein the specific vector for Group III is pDAB8505, and for Group IV is pDAB1472, and for Group V is pDAB1473, and for Group VI is pDAB1474, and for Group VII is pDAB1475.

CLAIMS 54-63 and 66 LINK THE INVENTIONS OF GROUPS III-VII

Groups VIII-XI, claim(s) 67 (in part) and 68, drawn to a method of producing an isolated monomeric anti-herpes simplex virus antibody by introducing into a plant cell a specified nucleic acid; wherein the specified nucleic acid for Group VIII is SEQ ID NO:1, and for Group IX is SEQ ID NO:5, and for Group X is SEQ ID NO:9, and for Group XI is SEQ ID NO:13. It is noted that the claims uses “and” and “or” in reference to the nucleic acids. If the Applicant elects an invention from one of Groups VIII-XI, they are advised to amend the claim to clearly recite which sequence is introduced into a plant cell. If more than one sequence is to be introduced, then this should be clearly stated as well.

Groups XII-XXIV, claim(s) 69 (in part), drawn to a nucleic acid molecule comprising a specified nucleic acid sequence or comprising a nucleic acid encoding a specified amino acid sequence; wherein the specified sequence for Group XII is SEQ ID NO:1, and for Group XIII is SEQ ID NO:5, and for Group XIV is SEQ ID NO:9, and for

Group XV is SEQ ID NO:13, and for Group XVI is SEQ ID NO:15, and for Group XVII is SEQ ID NO:16, and for Group XVIII is SEQ ID NO:17, and for Group XIX is SEQ ID NO:84, and for Group XX is SEQ ID NO:85, and for Group XXI is SEQ ID NO:2, and for Group XXII is SEQ ID NO: 6, and for Group XXIII is SEQ ID NO:10, and for Group XXIV is SEQ ID NO:14. It is noted that there are four amino acid sequences in addition to the nucleic acid sequence. If one of the amino acid sequences is encoded by one of the nucleic acid sequences, then these inventions will be rejoined as obvious over each other. The Applicant is advised to inform the Examiner if this is the case, so that they inventions can be rejoined.

2. The inventions listed as Groups I-XXIV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking groups I-XXIV is an immunoglobulin with at least on glycopeptides which lacks fucose, or a plant producing such an immunoglobulin or a nucleic acid encoding such an immunoglobulin. However, in the prior art (WO 01/31045; published on May 3, 2001) Bakker et al teach transgenic plants that have reduced fucosylation of an antibody (see Figure 3 D). Therefore, the technical feature linking the inventions of groups I-XXIV does not constitute a special technical feature as defined by PCT Rule 13.2 as it does not define a contribution over the prior art.

Accordingly, Groups I-XXIV are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

3. Claims 54-63 and 66 link the inventions of groups III-VII. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claims. Upon the allowance of the linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise including all the limitations of the allowable linking claims will be entitled to examination in the instant application. Applicants are advised that if any such claims depending from or including all the limitations of the allowable linking claims are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant applications. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP 804.01.

4. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process

claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CATHY K. WORLEY whose telephone number is (571)272-8784. The examiner can normally be reached on M-F 10:00 - 4:00, with additional variable hours before 10:00 and after 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cathy K. Worley/
Examiner, Art Unit 1638